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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,344	10/12/2001	Stephen G. Malloy Desormeaux	83095RLW	1357

7590

05/11/2005

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EXAMINER

MOE, AUNG SOE

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,344

Applicant(s)

MALLOY DESORMEAUX,  
STEPHEN G.

Examiner

Aung S. Moe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-22, 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

**Please note that this application has been assigned to a different Examiner.**

1. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 11-17 of copending Application No. 09/976,326 in view of Lourette et al. (U.S. 5,978,016).

This is a provisional obviousness-type double patenting rejection. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

It noted that although conflicting claims are not identical, they are not patentably distinct from each other because both Claims 1-15 of the instant Application 09/976,344 (hereinafter

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referred to as Application '344) and claims 1-13 of copending Application 09/976,326 (hereinafter referred to as Application '326) recited a method for capturing/handling images in a camera comprising the steps of: capturing a plurality of images pairs (i.e., see capturing step of Application '326), storing the initial electronic images in memory (i.e., see storing step of Application '326), recording in association with selected image pairs of the plurality (i.e., see recording step of Application '326); abridging said initial electronic images (i.e., please see changing/cropping steps of claim 1 and 5 of Application '326) of said selected image pairs; and replacing, in said memory, said initial electronic images (i.e., noted the replacing step of claims 1, 5 and 6 of Application '326. Particularly, claim 6 of Application '326 shows the replacing step of present claimed invention).

Furthermore, it is noted although the Claims 1-15 of the instant Application '344 shown the step of loading a film unit into the camera (i.e., see claim 8 of Application '326), Claims 1-15 of the instant Application '344 does not explicitly show the step of removing the film unit from the camera. However, Lourette '016 teaches the use of film unit and further shown the step of removing the film unit from the camera (i.e., see col. 20, lines 45+).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the claims 1-15 of the instant Application '344 as taught by Lourette '016 so that image data stored in the film can be retrieved from the photographic film and utilized in a photo-finishing operation as known to one of ordinary skill in the art at the time of the invention was made.

In view of the above, since the subject matters recited in the claims 1-15 of the instant Application '344 is encompassed by the claims 1-13 of copending Application '326, allowing the

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claims 1-15 of the instant Application '344 would result in an unjustified or improper timewise extension of the "right to exclude" granted by a patent.

***Allowable Subject Matter***

4. Claims 17-22, 24 and 25 are allowed.

***Conclusion***

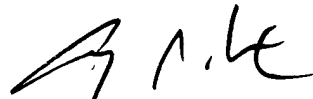
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2004/0201749 A1 is copending application (09/976,326) of the instant application '344.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung S. Moe whose telephone number is 571-272-7314. The examiner can normally be reached on Mon-Fri (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aung S. Moe  
Primary Examiner  
Art Unit 2612

A. Moe  
May 6, 2005